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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,009	07/21/2006	Thomas Manth	MANTH ET AL-1 PCT	1963
25889	7590	11/14/2008		
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1797	
			MAIL DATE	DELIVERY MODE
			11/14/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,009	<b>Applicant(s)</b> MANTH ET AL.	
	<b>Examiner</b> Krishnan S. Menon	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/21/06, 7/23/08</u>  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

Claims 1-20 are pending as preliminarily amended 7/21/06

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 11/811,622; claims 1-15 of 12/023194, . Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference application claims the limitations of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 8,9,11, 13, 18, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“Pelton” and “Francis” appear to be trade names from the turbine maker, which make the claims indefinite – trade names do not always represent the same product, and can change with time.

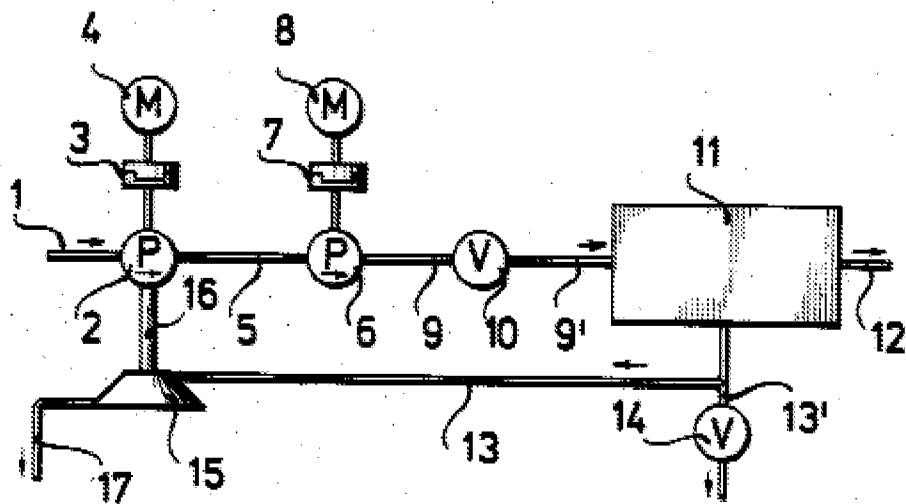
The range of kW and KW recited in claim 4 is confusing, especially with the second 3-phase motor with lower out put having a reversed range compared to the first. What is the difference between kW and KW?

***Claim Rejections - 35 USC § 102 and 103***

1. Claims 1,6,7,10 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohler (US 4,321,137).

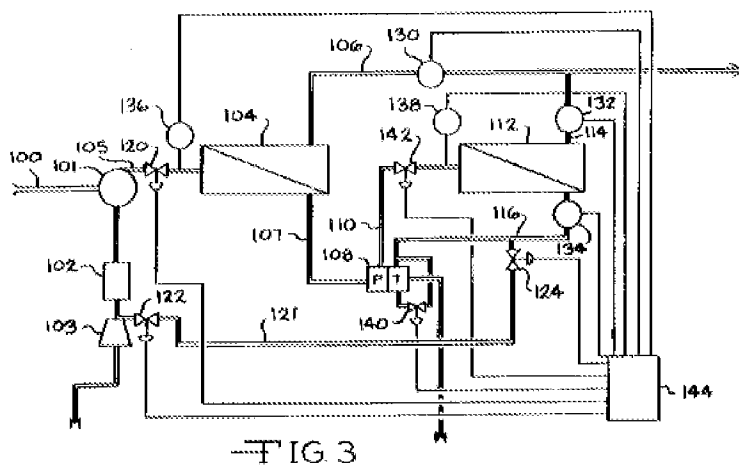
Kohler teaches a reverse osmosis system with a main pump (6) and a booster pump (2) (both having motors M), the booster pump coupled to a turbine (15) which recovers energy from the reject line (13).

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Provision for branch in concentrate line – 13' and valve 14.

2. Claims 10, 12 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Oklejas (US 6,139,740).



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Oklejas in figs 1-6 teaches a reverse osmosis system with pump (101) driven by a motor and a turbine, and booster pump (108) driven by a turbine (T); the turbines in this reference are in turn driven by the retentate or reject streams of the second stage reverse osmosis unit; the reject stream being split using a throttle valve to two streams, each running a turbine as claimed (see fig 3 reproduced above as an example)

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kohler, Oklejas et al (US 4,983,305 and 6,139,740) and Goulvestre et al (US 4,255,095).

**Kohler** teaches the system as described above. Further, the main pump (6) has variable speed (column 2, lines 47-50) and the booster pump (2) has motor disconnect clutch. The variable speed pump is the one with the turbine attached in the claims, which is considered as an obvious equivalent of the Kohler system, wherein the main pump has the variable speed.

**Oklejas** teaches multiple reverse osmosis units in series with multiple pump-turbine combinations – see figures – wherein the retentate stream from subsequent stages of reverse osmosis units are used in driving the turbines of pumps of the prior units. This reference teaches several different combinations of these arrangements. Particularly, Figs 13 and 14 of the '305 reference has the retentate of the third stage boosting the pressures for the feeds of the second and third stages; fig 13 with two booster turbines in series connection; fig 14 having a single turbine on common shaft

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with the two pumps. A parallel connection of two turbines by splitting the flow of retentate with a valve is taught by Oklejas'740.

**Goulvestre** teaches a turbo-pump with pump, turbine and external drive on common shaft – see figures and column 2, lines 4-7. This reference teaches the turbo-pump for recovering energy from the process fluid – see column 1, lines 19-48. The pump shown in the figures are also multi-stage.

Thus the claim limitations are known in the art, and it would be obvious to one of ordinary skill to combine the teachings of the se references to arrive at the applicant's invention, because such combinations would provide no more than predictable results. See *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1732, 82 USPQ2d 1385, 1390 (2007). “it is commonsense that familiar items have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle”. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”

Limitations on the motor such as three-phase motor and variable frequency drive, etc., are well known in the art, and do not add to patentability of the claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/  
Primary Examiner, Art Unit 1797